

REMARKS

Amendments to the Specification

The abstract and title of the invention have been amended to more accurately reflect the elected invention as required by the Examiner.

Claim Amendments

Claims 41 and 45 have been amended to be in independent form and to include all of the limitations of the base claim from which they depend.

Notice of Filing/Claim Fee(s) Due

Applicants note that a Notice of Filing/Claim Fee(s) Due accompanied the Office Action for the above-identified application. This Notice indicates that \$1624 is due in payment of the basic filing fee and additional claims fees for a large entity, and that no fees have been submitted.

Applicants note that a check in the amount of \$867.00 was mailed to the U.S. Patent and Trademark Office on May 11, 1998, in payment of the fees for a one-month extension of time (\$55.00), the basic filing fee of \$395.00, excess claims fee of \$352.00, and surcharge of \$65.00 for a small entity. The check was mailed along with two Verified Statements of Small Entity Status and transmittal letter, two originally-signed Declaration /Power of Attorney forms, Transmittal of Filing Fee and Declaration/Power of Attorney, copy of PTO 1533 and Petition for One-Month Extension of Time. Copies of these documents are enclosed, along with a copy of the date-stamped postcard receipt indicating receipt of these documents by the U.S. Patent and Trademark Office on May 14, 1998. A copy of the cancelled check is also enclosed. Thus, Applicants respectfully believe that the Notice was sent in error, and that all required fees have been properly paid. Verification is respectfully requested.

Priority

The Examiner states that Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §120 because the present application and the claimed priority application were not copending at the time the present application was filed. The Examiner states that the instant application has a filing date of October 9, 1997, and the claimed parent was abandoned on July 10, 1997.

Applicants note that a Notice to File Missing Parts was mailed from the U.S. Patent Trademark Office on May 9, 1997, in the claimed priority application (U.S. Serial No. 08/802,474), setting a due date for response of July 9, 1997. On October 9, 1997, a Petition for a Three-Month Extension of Time was mailed to the U.S. Patent and Trademark Office, extending the due date for response to October 9, 1997, along with payment of the processing and retention fee under 37 C.F.R. §1.53(d)(1) and §1.21(l). Copies of these documents, as well as a copy of the date-stamped postcard receipt indicating receipt of these documents by the U.S. Patent and Trademark Office, are enclosed. Also enclosed is a copy of a Notice of Abandonment for the priority application, acknowledging receipt of the above documents, and indicating receipt of the retention fee.

In view of these facts, Applicants believe that the priority application was pending as of October 9, 1997, the filing date of the instant application. Reconsideration of the entitlement to priority is respectfully requested.

Objection to the Specification

The Examiner has objected to the abstract because the Examiner states that it does not fully and accurately reflect the elected invention. The abstract has been amended as required by the Examiner.

The Examiner has also objected to the title of the invention as not descriptive of the elected invention. The title has been amended as required by the Examiner.

Reconsideration and withdrawal of the objection are respectfully requested.

Rejection of Claims 41, 43 and 45 Under 35 U.S.C. §112, Second Paragraph

Claims 41, 43 and 45 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The Examiner states that Claims 41, 43 and 45 are dependent from a non-elected claim. Claim 43 has been cancelled. Claims 41 and 45 have been amended to be in independent form and to recite all the limitations of the base claim from which they depend.

The Claims, as amended, even more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claims 41 and 45 Under 35 U.S.C. §103(a)

Claims 41 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gurtu *et al.* (*Analytical Biochemistry* 251:98-102 (1997)). The Examiner states that Gurtu *et al.* teach a method of quantitatively assaying caspase-3 activity wherein the caspase is associated with apoptosis using a fluorometric or colorimetric tag attached to a substrate of caspase. The Examiner states that Gurtu *et al.* do not teach the methods using isolated caspase or procaspase or active fragments and derivatives thereof, but that it would have been *prima facie* obvious to substitute the cell lysate employed by Gurtu *et al.* with an isolated caspase, procaspase or active fragments and derivatives thereof since one of ordinary skill in the art would expect the caspases from these sources to have different activities.

Claims 41 and 45 recite a method of identifying an agent which enhances a caspase or procaspase expressed in immature thymocytes, or an active derivative or fragment thereof, and a method of enhancing a caspase or procaspase expressed in immature thymocytes, or an active derivative or fragment thereof, respectively. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03; *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Gurtu *et al.* provide no teaching or suggestion that caspase-3 is expressed in immature thymocytes and thus do not teach or suggest all of the limitations of Claims 41 and 45. Thus, the Examiner has not established a *prima facie* case of obviousness of the claimed invention in view of Gurtu *et al.* Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claim 43 Under 35 U.S.C. §103(a)

Claim 43 is rejected under 35 U.S.C. §103(a) as being unpatentable over Gurtu *et al.* in view of Fearnhead *et al.* (*FEBS LETT.* 375:283-288 (1995); reference AY3). Claim 43 has been cancelled, obviating the rejection.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If

the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (781) 861-6240.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Lisa M. Treannie

Lisa M. Treannie

Registration No. 41,368

Telephone (781) 861-6240

Facsimile (781) 861-9540

Lexington, Massachusetts 02421-4799

Dated: August 3, 1999